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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,243	08/05/2003	Peikang Liu	AVERP3408US	6395

7590

01/06/2006

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EXAMINER

TRINH, MINH N

ART UNIT

PAPER NUMBER

3729

DATE MAILED: 01/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/634,243	Applicant(s) LIU ET AL.	
	Examiner Minh Trinh	Art Unit 3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 3, 10-16, 23 and 38-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-9 and 24-37 is/are rejected.
- 7) ☒ Claim(s) 2 and 17-22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/1/04, 6/24/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, species 1E (claims 1, 2, 4-9, 17-22 and 24-37) in the reply filed on 10/6/05 is acknowledged. Upon further review of amended product claims 38-50. These claims are product claims, since the method invention is elected, the product claims 38-50 and nonelected species other than elected 1E drawn to claims 3, 10-16 are withdrawn from consideration as the same reasons provided from previous action, dated 9/6/05 (as indicated in paragraph 1).

Furthermore, applicants contend that claims 1, 2, 4-9, 17-22, 24-39, 42-45, 49 and 50 are readable on the elected method invention (see "Remarks, page 9). The examiner disagrees for the following reasons: a) claims 38-50 are directed to an invention that is independent or distinct from the elected invention method because the inventions of Group I, II each have a separate status in the art and clearly have a separate field of search, and the search required for Group I is not required for Group II. Moreover, these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper. In accordance with MPEP §803, the examiner has demonstrated that the inventions of Group I and II are each independent or distinct as claimed and a serious burden would be placed on the examiner as discussed above. b) Applicants are not entitled to examination of multiple independent inventions in one application. Accordingly, product claims 38-50 are

withdrawn from consideration as being drawn to a non-elected invention, and the Restriction is hereby **made Final**.

An Office action on the merits of claims 1, 2, 4-9, 17-22 and 24-37 as follows:

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1, 4-9 and 24-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oberle (6476775).

Oberle discloses a method of making a radio frequency identification (RFID) device, comprising: forming a conductive seed layer 51 on a substrate 53 (see Fig. 4A); and attaching a strap 58 to the substrate (see Fig. 4c, col. 3, line 42 to col. 4, line10). Oberle, however does not teach wherein the attaching includes crimping to form crimped electrical connections between the seed layer and conductive leads of the

strap. It would have been an obvious matter of design choice to choose any desired mechanical attaching including the crimping connections between the seed layer and conductive leads of the strap first since applicant has not disclosed that these features are critical, patentably distinguishing features and it appears that the invention would perform equally well with the attaching step as described in the in the prior art reference (see Oberle's Fig. 8D and discussed at col. 4, lines 55-67).

As applied to claim 4-9 (see Figs. 4b-4E) for limitations of these claims.

As applied to claim 24, Oberle discloses the limitation of claim 24, i.e., where the forming of the seed layer includes depositing a conductive layer on the first surface (see Fig. 4c).

As applied to claims 25-26, it would have been an obvious matter of design choice to choose any desired plating techniques since applicant has not disclosed that the claimed limitation as recited in these claims would solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the electroplating as taught by the prior art reference (see Fig. 6).

Regarding claim 27, it would have been an obvious matter of design choice to form a depositing conductive layer having a particular size and/or shape configurations including that as recited in claim 27, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

As applied to claims 28-37, it would have been an obvious matter of design choice to choose any desired patterning techniques since applicant has not disclosed that the claimed limitation as recited in these claims would solve any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the electroplating as taught by the prior art reference (see Fig. 6).

Limitations of claims 29-37 are also met similar to the above discussion.

Allowable Subject Matter

4. Claims 2, 17-21 and 22 would be allowable if rewritten to include every limitation of the base claim and any intervening claims. The following is a statement of reasons for the indication of allowable subject matter: That the prior art as a whole fails to teach the subject matter recited in these claims i.e., crimping rod for connections seed and other integral structural recited in the above claims.

Conclusion

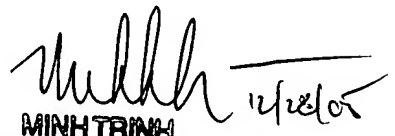
5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited for their teaching of RFID devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (571) 272-4569. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mt
12/28/05


MINH TRINH
PRIMARY EXAMINER